

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

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Ex parte ANDREW WATSON

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Application 09/453,800

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MAILED

MAY 14 2007

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on April 02, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

A review of the file indicates that on May 31, 2006, Appellant filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on May 31, 2006, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) ***Summary of claimed subject matter.*** A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) ***Grounds of rejection to be reviewed on appeal.*** A concise statement of each ground of rejection presented for review. For example, the statement “Whether claims 1 and 2 are unpatentable” would not comply with the rule, while the statements “Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones,” and “Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure” would comply with the rule. The statement cannot include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the “Argument” section of the brief.

An in-depth review of the Appeal Brief indicates that the following sections are deficient from the Appeal Brief filed May 31, 2006:

- 1) "Summary of Claimed Subject Matter," as set forth in 37 CFR § 41.37(c)(1)(v).
- 2) "Grounds of Rejection to be Reviewed on Appeal," as set forth in 37 CFR § 41.37(c)(1)(vi).

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c).

On January 12, 2005, the Examiner mailed a Final Rejection. On page 1 of the Final Rejection number 6) indicates that claims 1-21 are rejected. The grounds of rejection are listed as follows:

Claims 14 – 17 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Walker et al. (hereinafter Walker "478) U.S. Patent 5,970,478.

Claims 1-13 and 18-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. (hereinafter Walker '478) U.S. Patent 5,970,478 in view of Walker et al (hereinafter Walker '534) U.S. Patent 6,434,534.

Claims 1-11 and 14-21 were rejected under 35 U.S.C. § 102(e) as being unpatentable over Walker et al. (hereinafter Walker '478) U.S. Patent 5,970,478 as stated in the previous office action mailed 07 April 2004.

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The Examiner's Answer mailed August 11, 2006, only listed the following grounds of rejection:

Claims 14-17 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Walker et al. (hereinafter Walker '478) U.S. Patent 5,970,478.

It should be noted that the Examiner's Answer fails to discuss the rejection of claims 1-13 and 18-21. Clarification is required.

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Accordingly, it is ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed on May 31, 2006, defective;
- 2) notify appellant to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;
- 3) if necessary to vacate the Examiner Answer mailed August 11, 2006, to consider the supplemental Appeal Brief;
- 4) for determination regarding the status of claims 1-13 and 18-21, and if necessary, to vacate the Examiner's Answer mailed August 11, 2006, and issues a revised Examiner's Answer; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
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PJN/pgc

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